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Mailed: August 24, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Light Effects, Inc.

Serial No. 76583583

Hillary A. Brooks of Marger Johnson & McCollum for Light Effects, Inc.

Alison Holtz, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Hairston, Walters and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Light Effects, Inc. filed an application to register on the Principal Register the mark MOSIAC, in standard character form, for "window coverings, namely, translucent window film," in International Class 17.¹

The examining attorney issued a final refusal to register under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 76583583, filed March 29, 2004, based on use in commerce, alleging first use and use in commerce as of August 4, 2003.

U.S.C. §1052(e) on the ground that applicant's mark is merely descriptive of a characteristic or feature of applicant's identified goods.

Applicant has appealed and filed a main brief and reply brief, but did not request an oral hearing. The examining attorney also filed a brief.

The examining attorney contends that the mark is merely descriptive because the goods feature a mosaic design. The examining attorney included in the record a definition of "mosaic" from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) as, *inter alia*, "noun, a picture or decorative design made by setting small colored pieces, as of stone or tile, into a surface," and "verb, to adorn with or as if with mosaic." Additionally, the record includes excerpts from two third-party websites offering window films. One website, gilafilms.com, lists as "Decorative Window Films" four types that are named "Prism," "Dogwood," "Marble," and "Mosaic," which is described as "simulat[ing] stained glass."² The other website, decorativefilms.com, lists its many different "Decorative Glass Enhancement & Privacy Films," including one named "Atlantis Mosaic," which is described as "translucent

² Applicant stated that the examining attorney mistakenly referred to information from its competitor, Gila Films, as being an example of applicant's use. However, applicant stated that it inadvertently submitted the Gila Film sample with its specimen of use. Therefore, we have considered the submission in question as evidence of a third-party use.

embossed vinyl film[;] prism-like facets scatter the light making this privacy film look like colored glass" The examining attorney also submitted excerpts from various Internet websites advertising different products, each of which uses the term "mosaic" to refer to the surface design on the product, e.g., "faux mosaic fabric," "blue mosaic fabric shower curtain," and "floral mosaic rug."

Applicant contends that its mark is not merely descriptive, arguing that its goods are not mosaics nor are they made by a mosaic process; that even if its goods resemble a mosaic, the mark is registrable because of the many third-party registrations for marks including the term "mosaic" for goods that are also not mosaics or made by a mosaic process; and that consumers seeing the mark on the goods must engage in a thought process to determine the nature of applicant's goods because "mosaic" can be either a noun or a verb; that the mark is incongruous because mosaics are generally made from stone or tile and are opaque, whereas applicant's product is translucent and the common term for translucent window designs is "stained glass." Applicant makes the following statement (brief, p. 8):

[I]n addition to being a sheet rather than a *mosaic*, and being made out of a contiguous film rather than the process of *mosaicing*, applicant's window coverings do not resemble *mosaic*, insofar as mosaic strongly suggests design and intentional placement, while applicant's specimen shows a random cobblestone effect that fails to convey either design or pattern. As such, applicant's

specimen does not resemble *mosaic*, and as a result MOSAIC does not immediately call to mind an ingredient, characteristic or purpose of applicant's goods. [*Italics in original.*]

Applicant asks that the Board resolve doubt in favor of applicant.

In support of its position, applicant submitted a photocopy of a sample of its product and a photograph of its product on a window; a copy of third-party Gila Film's product packaging, which includes a representation of Gila's window film named "Mosaic"; and the declaration of applicant's president, Tom Hicks, describing the nature of its product, stating that it is not a mosaic for the reasons noted above and stating that the pattern on its window film is random and does not contain gaps as for grout. From the Internet, applicant also submitted lists resulting from Internet searches of stained glass products and businesses producing stained glass; a *Wikipedia* entry for "mosaic"; a definition from *Merriam-Webster's Online Dictionary* of "design" as "noun, 5a - an underlying scheme that governs functioning, developing, or unfolding - PATTERN, MOTIF, 6 - the arrangement of elements or details in a product or work of art, 7 - a decorative pattern, 8 - the creative art of executing aesthetic or functional designs, verb, 1 - to create, fashion, execute, or construct according to plan"; and excerpts from numerous websites pertaining to mosaic art, such as photographs of mosaic tile floors and articles

about artists and crafts, such as kits for making mosaic ceramic tile plates and other items.

Applicant submitted a long list of third-party registration numbers and the respective registered marks, each including the word "mosaic" as part thereof, and identifications of goods or services. This is not the proper form for submission of third-party registrations as evidence. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998). Accordingly, the third-party registrations have not been considered in our determination of mere descriptiveness. We hasten to add that the list of third-party registrations, even if considered, would not compel a different result in this case. First, we cannot give this list much, if any, probative value because we have no evidence of the status of any of the registrations or whether any of them are registered on the Principal Register, are subject to a claim of acquired distinctiveness, or include any disclaimers. Second, we are not bound by the USPTO's allowance of prior registrations which may have similar characteristics to applicant's application. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001).

The test for determining whether a mark is merely descriptive is whether it immediately conveys information

concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the examining attorney that MOSAIC is merely descriptive of a significant characteristic of applicant's translucent window film, naming the design applied to the window film. The evidence of record clearly establishes that applicant's goods are not mosaics as that term is defined in the dictionary or as explained in several of the Internet website excerpts. However, it is equally clear from the record that the term "mosaic" is used in

connection with window films by applicant's competitors, as well as by manufacturers on a number of different types of products that are not mosaics or made using a mosaic process, to describe a particular type of design on the window film and other products.

The mere fact that applicant's product is not an actual mosaic or made using a mosaic process is of no moment. It is settled that a term which would be merely descriptive as applied to the actual goods is deemed to be also merely descriptive of goods which only simulate the actual goods. For example, in *In re Guylay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), the court affirmed the Board's decision holding APPLE PIE to be merely descriptive of potpourri with a simulated apple pie scent; it was not dispositive that the potpourri's scent was not derived from actual apple pie. Likewise, in *In re J & D Brauner, Inc.*, 173 USPQ 441 (TTAB 1972), the mark THE BUTCHER BLOCK was held to be merely descriptive of "furniture for household use, namely, tables, serving carts, kitchen counters and cabinet tops comprised of protective decorative material, and desks," notwithstanding that the goods were not and would not be mistaken for actual butcher blocks, but were instead merely covered with a laminated decorative board designed to simulate the appearance of a butcher's block.

Similarly, we are not convinced by applicant's additional arguments. In particular, there is nothing in the record that limits actual mosaics to stone and tile or materials that are opaque; and such a point is irrelevant because we have acknowledged that we are concerned with a design that resembles a mosaic, not an actual mosaic. Nor does the record support a conclusion that applicant's design is more aptly described as having a "stained glass" design than a "mosaic" design. The fact that stained glass may also describe the design on applicant's product is not a question before us and, in view of the evidence in this record, such a finding would not render MOSAIC an inherently distinctive mark in connection with applicant's product. Finally, there is nothing in the record that limits mosaics to carefully planned designs rather than random designs, or that indicates purchasers of applicant's product would perceive such a distinction.

We conclude that when applied to applicant's services, the term MOSAIC immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely the design of its translucent window film. Contrary to applicant's contention, nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's

Serial No. 76583583

services to readily perceive the merely descriptive significance of the term MOSAIC as it pertains to the identified goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.